

REMARKS

In paragraph 1 the Examiner states that the invention must be restricted to either claims 1-9, drawn to an imaging member, or claims 10-17 drawn to a method of cutting an imaging member. Restriction has been required between Group I, claims 1-9, drawn to an imaging member, classified in Class 428, subclass 304.4, Group II, and claims 10-17, drawn to a method of cutting an imaging member, classified in Class 396, subclass 613.

In paragraph 2 the Examiner states that the inventions of Group I and II are related as product and process of use. The Examiner states that the inventions can be shown to be distinct if either or both of the following can be shown: (1) the process of using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using the product. The Examiner states that in the instant case the process for using the product as claimed can be practiced with another materially different product such as cutting non-coated plain papers.

The Examiner indicates that, because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classifications, restriction for examination purposes as indicated is proper. This Restriction Requirement is respectfully traversed.

The Examiner has not shown that the cutting device is suitable for non-coating paper. However, even if it were shown that non-coating paper was suitable, the use of non-coating paper would not meet the terms of claims 10-17 because claims 10-17 incorporate the sheet of claims 1-9.

Furthermore, under compact examination the inventions should be examined together for effective use of time, as art and the method require overlapping searches. As stated by the Examiner, Claim 1 is limited to an imaging element, and Claim 10 is drawn to a method of cutting an imaging member. However, both independent claims claim a base comprised of a closed cell foam core sheet and adhered to an upper and lower flange sheet, where the foam core has a modulus of between 100 and 2758 MPa and a tensile toughness between 0.344 and 35 MPa and where the upper and lower flange sheet has a modulus of between 1380 and 20000 MPa and a toughness between 1.4 and 210

MPa. Both independent claims are clearly limited to imaging members made from the same combination of materials. Therefore, it is suggested that commonality exists between the two Groups identified by the Examiner with respect to structure, tensile toughness, and modulus of the sheets. Coextensive searching of the two Groups would not prove seriously burdensome to the Examiner, but would instead be most efficient. Therefore, it is respectfully requested that the Restriction Requirement be reconsidered and withdrawn, and that all claims now pending be examined.

In order that this response be complete, the Applicant confirms the telephone election, made with traverse, of June 25, 2003 and hereby elects to prosecute the invention of Group I, claims 1-9. Claims 10-17 are withdrawn from further consideration, under 37 CFR 1.142(b), as being drawn to a non-elected invention.

In paragraph 6 the Examiner states that the disclosure is objected to because it appears that the instantly claimed invention is a continuation of both U.S. Application 09/723,518 and/or 09/723,682, now issued U.S. Patent No. 6537656 and 6447976, respectively. The Examiner suggests that the Applicant amends the Specification on page 1 to include the proper continuation data. The Applicant respectfully transverses this objection. The claims in the present application could not have been made in previous cases. Therefore, this is not a continuation of the previous applications, and reconsideration and withdrawal of the present objection is respectfully requested.

In paragraph 8 the Examiner states that claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Application regards as the invention. The Examiner states that where the Applicant acts as his or her own lexicographer to specifically define a term of claim contrary to its ordinary meaning, the written description must clearly define the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the Applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (fed. Cir. 1999). The Examiner states that the term "flange" in claim 1 is used by the claim to mean "skin", "cover" or "outer", while the accepted meaning is "A

protruding rim, edge, rib, or collar, as on a wheel or a pipe shaft, used to strengthen an object, hold it in place or attach it to another object” (The American Heritage® Dictionary of the English Language, Third Edition copyright © 1992 by Houghton Mifflin Company). The Examiner states that the term is indefinite because the specification does not clearly redefine the term.

Also, the Examiner states that in claim 2, line 2 and throughout the remaining claims, the term “caliper” is used by the claim to mean “thickness”, while the accepted meaning is “An instrument consisting essentially of two curved hinged legs, used to measure thickness and distances” (The American Heritage® Dictionary of the English Language, Third Edition copyright © 1992 by Houghton Mifflin Company). The Examiner states that the term is also indefinite because the specification does not clearly redefine the term. The Examiner suggests change “caliper” to “thickness”. The Applicant respectfully transgresses these rejections.

A fundamental principle contained in 35 U.S.C. 112, second paragraph is that applicants are their own lexicographers. They can define in the claims what they regard as their invention essentially in whatever terms they choose so long as the terms are not used in ways that are contrary to accepted meanings in the art. Applicant may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim, which makes clear the boundaries of the subject matter for which protection is sought. Applicants need not confine themselves to the terminology used in the prior art, but are required to make clear and precise the terms that are used to define the invention whereby the metes and bounds of the claimed invention can be ascertained. Accordingly, when there is more than one definition for a term, it is incumbent upon applicant to make clear which definition is being relied upon to claim the invention.

The usage of the term “flange” in the present application is consistent with the definition provided by the Examiner. The Examiner states that “flange” is defined as a “protruding rim, edge... to strengthen an object, hold it in place or attach it to another object” (The American Heritage® Dictionary of the English Language, Third Edition copyright © 1992 by Houghton Mifflin Company). On page 5 lines 22-25 of the present application it is stated that the

flange layers provide stiffness on either side of the foam core. Therefore, the flanges in the present application are protruding edges on either side of the foam core, which act to strengthen the foam core. Therefore, the use of “flange” in the present application is consistent with the cited dictionary definition. However, reliance on the dictionary definition is not necessary because “flange” is clearly defined within the specification on page 5 lines 22-25. Since the term flange is clearly defined in the specification, and the applicant is not required to use the terminology in the prior art, the use of the term “flange” in the present application is appropriate. Therefore, it is respectfully requested that the present rejection be reconsidered and withdrawn.

Webster’s Third New International Dictionary (© 1961 by G & G Merriam Co.) defines caliper as a “thickness esp. of paper, paperboard, or a tree”. Therefore, the Applicant’s use of this term to mean “thickness” is consistent with an already accepted meaning of this term. Furthermore, on page 8 lines 21-26 of the present application it is clearly indicated that “caliper” refers to thickness. Since Applicants are not required to confine themselves to the terminology used in the prior art, and the term “caliper” is clearly defined in the specification, the use of this term in the present application is appropriate. Therefore, it is respectfully requested that the present rejection be reconsidered and withdrawn.

The Examiner further states in paragraph 8 that in claim 1 the structural relations of the claimed elements are vague and indefinite. For Example, the Examiner points out that at line 3, the phrase “upper and lower” fails to clearly claim the structural relations of the flanges to the imaging layer and the foam core. The Examiner suggests that the claim be rewritten so as to clearly claim the structural relations. The Applicant respectfully transposes this rejection.

Claim 1 discloses that the flange layers are adhered to the upper and lower sides of the foam core. Page 5 lines 24-25 also discloses that the flange layers are used to create stiffness on either side of the foam core. Since claim 1 and the specification define the location of the flange layers in relation to the foam core, it is not believed that any further description is necessary. It is believed that the present invention provides a novel contribution to the art, and, in all fairness, the inventors should be entitled to the full breadth of coverage of their

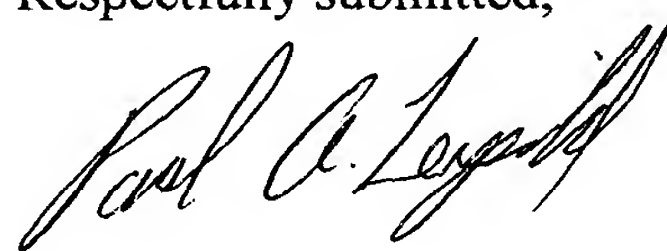
contribution to the art as presently claimed. Therefore, the Applicant respectfully requests that the present objection be reconsidered and withdrawn.

In paragraph 10 the Examiner states that claims 1-8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3, 5, 10, 12, 19 and 21-23 of U.S. Patent No. 6537656 to Dontula et al. The Examiner states that although the conflicting claims are not identical, they are not patentably distinct from each other. The Examiner states that claims 1, 3, 5, 10, 12, 18, 19, and 21-23 of U.S. Patent No. 6537656 disclose all the features of claims 1-9 of the instantly claimed invention, except an express teaching of the toughness of the foam core sheet and the skin (or flange) sheets. However, the Examiner notes that Dontula does teach that the skin (or flange) sheets are chosen to satisfy specific requirements of flexural modulus, etc. to alleviate the cutting problems (column 4, line 63 to column 5, line 19). As such the Examiner states that it is believed that a suitable toughness is either inherently disclosed by Dontula, or an obvious optimization to one of ordinary skill in the art, motivated by the desire to minimize the cutting problems. In paragraph 11 the Examiner states that claims 1-8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3, 5, 8, 8, and 10-12 of U.S. Patent No. 6447976 to Dontula et al. The Examiner states that although the conflicting claims are not identical they are not patentably distinct from each other. The Examiner states that for claims 1-9, claim 1, 3, 5, 8, 9, and 10 of U.S. Patent No. 6447976 disclose all the features of instantly claimed invention except express teaching of the modulus and toughness of the foam core sheet and the skin (or flange) sheets. However, the Examiner notes that Dontula does teach that the skin (or flange) sheets are chosen to satisfy specific requirements of flexural modulus, etc. to alleviate the cutting problems (column 5, line 45 to column 6, line 2). The Examiner states that it should be noted that a suitable thickness of skin layer is clearly inherently disclosed by claims 3 and 8. As such, the Examiner states that it is believed that a suitable toughness is either inherently disclosed by Dontula, or an obvious optimization to one of ordinary skill in the art, motivated by the desire to minimize the cutting problems. These rejections are respectfully traversed.

In accordance with 37 CFR 1.321(c) enclosed is a terminal disclaimer which is believed to overcome the double patenting rejections. Therefore, reconsideration and withdrawal of the present rejection is respectfully requested.

In view of the foregoing amendments and remarks, reconsideration of this patent application is respectfully requested. A prompt and favorable action by the Examiner is earnestly solicited. Should the Examiner believe any remaining issues may be resolved via a telephone interview, the Examiner is encouraged to contact Applicants' representative at the number below to discuss such issues.

Respectfully submitted,



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